

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Newly submitted Claims 49-55 are presently active in this case, Claims 42-48 having been cancelled by way of the present Amendment.

In the outstanding Office Action, the drawings were objected to under 37 C.F.R. §1.83(a) as not showing every feature recited in the claims, and particularly the "focusing means positionally decoupled from the scanning mechanism" of Claims 44 and 45; and the "positionally decoupled lens placed between the cantilever and the photodetector working in conjunction with the focusing means consisting of one or more lenses" of Claims 46 and 47. Also, the specification was objected to as not providing support for the subject matter recited in Claims 44-47 and Claims 44-47 were therefore rejected under 35 U.S.C. §112 first paragraph as directed to new matter.

However, Claims 42, 43 and 48 were indicated as being allowable.

Applicants acknowledge with appreciation the indication that Claims 42, 43, and 48 are allowable. However, in review of these claims as formally presented in the amendment filed

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October 31, 1995, it was noticed that due to typographical error, the phrase "[a stylus mounted on said cantilever;]" was inadvertently included in each of independent Claims 42, 44, 46 and 48. Since the original intent was that a reference to the stylus not be included in these independent claims, and to avoid confusion, Claims 42-48 have been cancelled and replaced by new Claims 49-55. Claims 49, 50 and 55 correspond identically to allowable Claims 42, 43 and 48, and therefore are also believed to be allowable.

Applicants further gratefully acknowledge the courtesy of a telephone interview granted to Applicants' attorney on March 19, 1996, at which time the Examiner clarified the basis for the rejection of Claims 44-47. Specifically, the Examiner noted that Claim 44 reads on the Figure 7 embodiment, and that it was not clear that the lens 60 of Figure 7 was positionally decoupled from the scanner. The Examiner further noted that it was not clear to which embodiment Claims 46-47 were directed. Applicants' attorney identified the Figure 12 embodiment, and specifically lens 110, as providing support for the subject matter of Claims 46-47. However, no agreement was reached, pending the Examiner's detail reconsideration of the Claims upon formal submission of a response to the outstanding Office Action.

In light of the discussions with the Examiner on March 19, 1996, rejected Claims 44-47 have been cancelled and replaced by new Claims 51-54. Claim 51 (corresponding to cancelled Claim 44) has been drafted to clarify that the light source and focusing means recited in Claim 51 is positionally decoupled from --a scanning motion of said scanning mechanism--. Claim 53 is the same as previously presented Claim 46, with the exception of the recitation of a light source and focusing means --comprising-- one or more lenses that --emit-- a beam of light onto said cantilever, thereby employing open ended versus closed ended language, and in the recitation of at least one additional lens, positionally decoupled from --a scanning motion of the scanning mechanism--. Claim 54 is the same as Claim 47 with the exception that at line 2 Claim 54 has been clarified to refer to --said at least one additional lens--. The above changes are believed to find clear support in Applicants' disclosure as originally filed, and as described hereinafter these changes are not believed to raise a question of new matter. Furthermore, in view of the changes, the various grounds for objection and rejection are traversed, for the reasons as next discussed.

In the outstanding Office Action, Claims 44-47 were rejected due to the recitation in Claim 44 of "focusing means positionally decoupled from the scanning mechanism" and due to the recitation in Claim 46 of the similar limitation of a

"positionally decoupled" language and on the basis that the drawings fail to show the claimed elements.

In response, Applicant would like to clarify the intent of the language recited in rejected Claims 44-47 and explain how the alternative wording presented in the newly submitted claims is both more clear and more accurate than the language recited in the cancelled claims.

More particularly, in Claim 44 the prior phrase to "focusing means positionally decoupled from the scanning mechanism" referred to the lens 60 shown in Figure 7. The lens 60 is used to focus the light beam before steering by the beam steering lens 63 in Figure 7. However, as is believed evident to those skilled in the art, the lens 60 of Figure 7 corresponds to the lens 40 of Figure 4, for example, and the lens 63 of Figure 7 corresponds to the beam steering means 43 of Figure 4. The specification at page 16, lines 14-17 discloses:

...first lens 40 is disposed between the laser 10 and the scanner 12, or attached to a fixed part of the scanner 12. An optical assembly 43 is mounted on scanner for guiding beam 44 on cantilever 14. ...

Thus, the specification clearly indicates that the lens 40, which corresponds to the lens 60, may be positionally decoupled from the scanning motion of the scanner, while the

steering means 43 is mounted on the scanner and hence moves in tandem with the scanning mechanism. On the other hand, the focusing lens 60 does not move with the scanning mechanism and was therefore described in cancelled Claim 44 as "positionally decoupled from the scanning mechanism." In fact, since the lens 40, and also the lens 60, may be mounted external to the scanner or mounted to a fixed part of the scanner, as described at column 7, lines 14-16 of the original specification, Applicants believe that it is more accurate to state that the focusing means is --positionally decoupled from a scanning motion of the scanning mechanism-- (Claim 51), or that the at least one additional lens is --positionally decoupled from a scanning motion of the scanning mechanism-- (Claim 53). Claims 51 and 53 are directed to the two mounting arrangements, i.e., mounting the lens 40 or the lens 60 apart from the scanner and therefore clearly positionally decoupled from the scanning motion of the scanning mechanism (Claim 51), or mounting the lens 40 or 60 to a fixed part of the scanner, i.e., a part which does not undergo scanning motion, such that the lens is positionally decoupled from the scanning motion of the scanner, consistent with and supported by the disclosure at page 16, lines 14-16.

In further support of the position that the lens 60 of Figure 7 is functionally comparable to the lens 40 of Figure 4 and is positionally decoupled from the scanning motion of the scanner, attention is directed to original Claim 12, now

cancelled, which defined the subject invention in terms of a focus lens, corresponding to the lens 60 of Figure 7, "mounted at an arbitrary position" and a steering lens, corresponding to the lens 63, "mounted in or alongside the scanner". Note also the specification at page 21, lines 4-5 describes the lens 63 as "mounted to a moving part of the scanner." It is therefore respectfully submitted that the original specification, including original Claim 12, provides support for the subject matter of Claim 51.

In order to clarify in the drawings that the lens 63 of Figure 7 is coupled to the scanner 12, submitted herewith is a separate letter requesting approval for drawing changes, specifically, changes to Figure 7 showing the lens 63 coupled to the scanner 12 in the same way that the lens 43 of Figure 4 is shown coupled to the scanner 12. Similarly, approval is also requested to show the steering lens 71 in Figs. 8 and 9 as coupled to the scanner, consistent with pages 24 and 25 of the specification.

Further, in support of the language of Claim 53, Applicants refer to the lens 110 in Figure 12, and similar arrangements. From the drawings and from the text at page 31 of the original specification, it is respectfully submitted that it is clear that the lens 110 is not scanned by the scanning mechanism 12, and is in fact also physically decoupled from the scanning mechanism and certainly physically decoupled from the scanning motion of the scanning mechanism.

There is no mention or indication whatsoever in the original application that the lens 110 is coupled to the motion of the scanner in any way. Accordingly, it is respectfully submitted Figure 12 provides another basis that Claim 53 is supported in Applicants' disclosure as originally filed, and does not raise a question of new matter.

Also, the specification has been amended at page 29, line 18 to include a specific reference to the reference numeral designation --100-- to refer to the point source 100 shown in Figures 11-13. These changes are not believed to raise a question of new matter, but are believed self-evident from the original disclosure.

In view of the above amendment and in view of the above explanation, the several grounds for rejection and objection are believed to have been traversed. Further, since the differences between the newly submitted claims and the cancelled claims are minor and relatively easily understood, no new issues requiring further consideration and/or search are believed to have been raised. Especially by inspection of the drawings, it is believed clear that the present amendment and explanation overcome the outstanding grounds for rejection and objection and place the application in condition for allowance. Accordingly, it is respectfully requested that the present amendment be entered under 37 C.F.R. §1.116.

Further, since the present Amendment is believed to place the application in condition for formal allowance, an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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